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EXAMINER

GARCIA, ERNESTO

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/726,589
Filing Date: December 01, 2000
Appellant(s): KRIMM ET AL.

Gary R. Edwards
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 17, 2006 appealing from the Office action mailed November 3, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1, 4, 8, 20, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Sander, 6,182,527.

Regarding claim 1, Sander discloses, in Figures 1, 3 and 4, a functional component comprising at least three stamped parts **11, 12, 13**. One of the stamped parts **11, 12, 13** is a middle stamped part **11**. The stamped parts **11, 12, 13** lie flat sandwiched against one another. The stamped parts **11, 12, 13** are unreleasably connected to one another and each of the stamped parts **11, 12, 13** have at least two engagement holes **2, 7**. The engagement holes **2, 7** are arranged congruently with respect to one another. At least one of the engagement holes **2, 7** in the middle stamped part **11**, has a hole wall **16** provided with an elastomeric plastic cover **24**.

Regarding claim 4, the plastic cover **24** is around a hole edge **A** (see marked-up attachment; Fig. 4). Appellants are reminded that the method of forming the plastic cover by injection-moulding plastic is not germane to the issue of patentability of the functional component itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

Regarding claim 8, Sander discloses spacer lugs **A2** (see marked-up attachment; Fig. 3) on inner sides of the outer stamped parts **12,13** facing towards the middle stamped part **11**. The spacer lugs **22** are formed from a material that is harder than the injection-moulded plastic (claim 5, recites the plates made of metal and thus the lugs are made of metal; metal is harder than plastic).

Regarding claim 20, Sander discloses a gate plate comprising at least three stamped metal sheet parts **11-13** and an elastomeric plastic cover **24**. The parts **11-13** are stacked together sandwiched. Each of the parts **11-13** includes at least one engagement hole **7** aligned with engagement holes **7** in the other parts **11-13**. The cover **24** is provided to surround at least a portion of the engagement hole **7** in a middle one of the parts **11-13**.

Regarding claim 24, the cover **24** is clicked into place on the metal part **11** (Fig. 5 or Fig. 6)

Regarding claim 25, the cover **24** is injection-moulded onto the middle part **11** (col. 5, line 48).

(10) Response to Argument

Appellants argue that the Amendment filed on February 11, 2004 establishes that the Sander patent is not prior art because appellants submitted a declaration under 37 CFR

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1.131. In response, the examiner held the declaration ineffective because the statement does not specify where the activities took place.

The affidavit was further ineffective to overcome the Sander reference because the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Sander reference. The documents failed to state facts as to when and where the invention was reduced to practice. "Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that appellant had been diligent" (citation omitted). See MPEP 715.07(a) Diligence.

The evidence submitted is insufficient to establish diligence from just prior to the effective date of the Sander reference to either a constructive reduction to practice or an actual reduction to practice. A mere statement that appellants were diligent without facts is insufficient to satisfy 37 CFR 1.131. Appellants must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by the appellants.

Even if appellants are able to overcome the above stated deficiencies, the affidavit will not be effective to overcome the prior art because the Sander reference is a U.S. patent claiming the same invention as appellants. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same

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patentable invention, see MPEP § 2306 and 715.05 Appellants argue that the Sander invention is not the same because the claims in the reference is missing limitations. In particular, the appellants argue that Sander fails to claim "at least three stamped metal sheet parts stacked together sandwiched". In response, this argument is not persuasive because the claims are to the "same invention" albeit more broadly claimed. Sander inherently discloses the stamped metal sheet parts sandwiched together. In particular, Sander states "compressing the elastic material" to fasten the sheets together (see col. 1, lines 44-50 and col. 3, lines 3-5). The fact that the claims in Sander do not have the same exact language as appellants does not render the claimed invention not being the same when both Sander's and appellants' specifications and the drawings provide evidence that the inventions are the same albeit claimed in varying scope.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ernesto Garcia



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